

Remarks

**Legal, Practical and Equitable Considerations Mandate
Examination of Applicant's Claims in a Single Application**

A close examination of the legal, practical and equitable considerations surrounding this application compels withdrawal of the examiner's restriction requirement and requires examination of all the claims pending in the application.

In levying the restriction requirement, the examiner divided the claims pending in the application into five groups. The examiner asserted that Group I embraced claims 1-30, 49-52 and 68-82 which are purportedly drawn to "a container having a pump (or pump components)" and which the examiner asserted to be classified in class 222, subclass 333.

The examiner asserted Group II to embrace claims 31-36 and 83-96, which are purportedly drawn to a "method of furnishing liquid color to a plastics [sic] resin processing machine" and which the examiner asserted to be classified in class 222, subclass 1.

The examiner asserted Group III to embrace claims 37, 53 and 54 which are purportedly drawn to a "methods of switching color supply sources for plastic resin being molded or extruded", which the examiner asserted to be classified in class 264, subclass 78.

The examiner asserted Group IV to embrace claims 38-48 which are purportedly drawn to a "reciprocating diaphragm pump", which the examiner asserted to be classified in class 417, subclass 398.

The examiner further asserted Group V to embrace claims 55-67 which are purportedly drawn to “a conduit connector system with inserted section”, which the examiner asserted to be classified in class 285, subclass 31.

The examiner then asserted that the claims in these five groups defined inventions which were purportedly “distinct” and that such distinctness mandated restriction.

Applicant respectfully notes that in the restriction context the test for whether inventions, defined by groups of claims, are “distinct” is a multi-prong test: “Distinct means that two or more subjects as disclosed are related...but are capable of separate manufacture, use, or sale as claimed, **AND ARE PATENTABLE** (novel and unobvious) **OVER EACH OTHER**”. *MPEP 802.01*. **(EMPHASIS IN THE ORIGINAL)**

The examiner asserted that the inventions of groups 1 through 5 were all related, either as subcombinations allegedly disclosed as being usable together in a single combination (Group 4 vis-à-vis Group 5), or as a process and apparatus for its practice (Group 1 vis-à-vis Group 2; Group 1 vis-à-vis Group 3; Group 2 vis-à-vis Group 4; Group 2 vis-à-vis Group 5; Group 3 vis-à-vis Group 4; and Group 3 vis-à-vis Group 5) or as combination and subcombination (Group 1 vis-à-vis Group 4; Group 1 vis-à-vis Group 5; and Group 2 vis-à-vis Group 3). (Hence the examiner has conceded on the record that the inventions of the five groups are “related.”) The examiner then contended that the subcombinations “are distinct from each other if they are shown to be separately usable”¹, that the

¹ Citing section 806.05(d) of the Manual of Patent Examining Procedure

process and apparatus groupings were distinct because either “(1) the process as claimed can be practiced by another materially different apparatus or by hand or (2) the apparatus as claimed can be used to practice another and materially different process”², and that the combination/subcombination groupings were distinct from one another since it could be shown that “(1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations.”³

Notably, in none of the three distinctness situations did the examiner make any reference whatsoever to the patentability prong of the distinctness test, namely whether the inventions (defined by each one of the separate, allegedly distinct, group of claims) are novel and unobviously patentable respecting the inventions defined by the other, allegedly distinct group of claims.

**The “Process/Apparatus for its Practice” Restriction-- MPEP 806.05(e)--
Group 1 vis-à-vis Group 2**

In contending that the inventions of Groups 1 and 2, which are for apparatus and method respectively, are distinct the examiner asserts that distinctness follows if it can be shown either that the process as claimed can be practiced by another materially different apparatus or by hand or that the apparatus as claimed can be used to practice another and materially different process; the examiner cites section 806.05(e) of the Manual of Patent Examining Procedure in support of this position. Further respecting the inventions of

² Citing section 806.05(e) of the Manual of Patent Examining Procedure

³ Citing section 806.05(c) of the Manual of Patent Examining Procedure

Groups 1 and 2 and the alleged distinctness therebetween the examiner then contends that “the container could be used to provide a different liquid such as water or could be used to furnish liquid to a different location.”

Applicant takes issue with this position by the examiner. Specifically, when the examiner contends that “in this case the container could be used to provide a different liquid such as water”, applicant respectfully submits that this would not be “another and materially different process” as required by MPEP 806.05(e) for a finding of distinctness between apparatus and process. Similarly, when the examiner contends that the container “could be used to furnish liquid to a different location”, applicant respectfully submits this does not lead to a finding of distinctness but rather evidences a misreading of the claims on the part of the examiner. The apparatus claim only recites that the pumped liquid color is delivered “at the container exterior”. The claim does not specify any “location” for delivery of the pumped liquid color, let alone any “different location” as the examiner apparently misapprehends respecting the claim. Accordingly, applicant respectfully submits that the examiner’s basis for asserting distinctness as between the inventions of Groups 1 and 2 is misplaced. Hence, the restriction between the inventions of Groups 1 and 2 should be reconsidered and withdrawn.

Applicant further notes that in requiring restriction and alleging distinctness between the claims of Groups 1 and 2, the examiner has not addressed the patentability prong of the distinctness test and has made no showing whatsoever or even an assertion that the claims of Groups 1 and 2 are unobviously

patentable respecting one another. Applicant respectfully notes that the burden is on the Examiner to make such a showing of unobvious patentability between the suggested claim groups when making a restriction requirement. With the official action lacking any analysis of the patentability prong of the distinctness test or the process/apparatus for its practice restriction of the claims of Group 1 vis-à-vis the claims of Group 2, applicant respectfully submits that the restriction requirement as between the claims of Groups 1 and 2 is deficient and, accordingly, should be reconsidered and withdrawn.

**The “Process/Apparatus for its Practice” Restriction-- MPEP 806.05(e)--
Group 1 vis-à-vis Group 3**

In contending that the inventions of Groups 1 and 3, which are for apparatus and method respectively, are distinct the examiner asserts that distinctness follows if it can be shown either that the process as claimed can be practiced by another materially different apparatus or by hand or that the apparatus as claimed can be used to practice another and materially different process; the examiner cites section 806.05(e) of the Manual of Patent Examining Procedure in support of this position. Further respecting the inventions of Groups 1 and 3 and the alleged distinctness therebetween, the examiner then contends that “the container could be used to provide a different liquid such as water or could be used to furnish a liquid to a different location. Also the apparatus could be used in a method which would requires only a single container, rather than two.”

Applicant respectfully submits that using the container to provide a different liquid such as water would not constitute practice of a “*materially different*” process. For purposes of restriction analysis only, applicant asserts that changing the liquid being pumped does not amount to a material change in the process.

The examiner further contends that the apparatus could be used in a method requiring only a single container, rather than two containers and applicant does not dispute this position. However, and again for purposes of restriction analysis only, applicant submits that use of a method requiring only a single container would not amount to practice of the claimed process using another materially different apparatus. Accordingly, applicant respectfully submits that the examiner’s basis for asserting distinctness as between the inventions of Groups 1 and 3 is misplaced and that the restriction as between the inventions of Groups 1 and 3 should be reconsidered and withdrawn.

As with the restriction between the claims of Groups 1 and 2, the examiner has made no assertion respecting the unobvious patentability of the claims of Group 1 vis-à-vis Group 3. Accordingly, one of the two prongs of the distinctness test has not been addressed in the official action requiring restriction as between the claims of Groups 1 and 3; this being the case, the restriction requirement is deficient and should be reconsidered and withdrawn.

**The “Process/Apparatus for its Practice” Restriction-- MPEP 806.05(e)--
Group 2 vis-à-vis Group 4**

In contending that the inventions of Groups 2 and 4, which are for process and apparatus respectively, are distinct the examiner asserts that distinctness follows if it can be shown either that the process as claimed can be practiced by another materially different apparatus or by hand or that the apparatus as claimed can be used to practice another and materially different process; the examiner cites section 806.05(e) of the Manual of Patent Examining Procedure in support of this position. Further respecting the inventions of Groups 2 and 4 and the alleged distinctness therebetween, the examiner then contends that in this case, the apparatus could be used to provide a different liquid such as water or could be used to furnish liquid to a different location.

Applicant again takes issue with this position by the examiner. Again, when the examiner contends that “in this case the apparatus could be used to provide a different liquid such as water”, applicant respectfully submits that this would not be another *materially different* process” as required by MPEP 806.05(e) for a finding of distinctness between apparatus and process. Moreover, applicant respectfully submits, **for restriction analysis purposes only**, it might be difficult to find unobvious patentable distinction as between using the apparatus to provide liquid color and using the apparatus to provide water.

Similarly, with the examiner contending that the apparatus could be used to furnish liquid to a different location, the liquid color diaphragm pump subject matter of independent claim 38 (which has been consigned to Group 4 by the examiner) makes no recitation of the position at which liquid is furnished. If the

examiner is referring to the claims of Group 2 with respect to the position that which liquid is furnished, independent claim 31 consigned to Group 2 recites only "pumping said liquid color material out of said container via said outlet". There is no recitation in independent claim 31 of any particular location at which the liquid color is furnished, other than being furnished at the outlet from the pump, which is inherent in any pumping apparatus. Accordingly, applicant respectfully submits that the basis for asserting distinctness as between the inventions of Groups 2 and 4 is not well-founded and essentially without support.

Applicant incorporates by reference applicant's position, as set forth above regarding the restriction between the claims of Groups 1 and 2 and between the claims of Groups 1 and 3, regarding the lack of any statement in the official action regarding the presence of unobvious patentability as between the claims of Groups 2 and 4, which is required as set forth above. This is a second reason that the restriction requirement as between the inventions of Groups 2 and 4 is not well founded.

Accordingly, applicant respectfully submits that the examiner's basis for asserting distinctness as between the inventions of Groups 2 and 4 is misplaced and, hence, that the restriction between the inventions of Groups 2 and 4 should be reconsidered and withdrawn.

**The "Process/Apparatus for its Practice" Restriction-- MPEP 806.05(e)--
Group 2 vis-à-vis Group 5**

In contending that the inventions of Groups 2 and 5, which are for method and apparatus respectively, are distinct the examiner asserts that distinctness

follows if it can be shown either that the process as claimed can be practiced by another materially different apparatus or by hand or that the apparatus as claimed can be used to practice another and materially different process; the examiner again cites section 806.05(e) of the Manual of Patent Examining Procedure in support of this position. Further respecting the inventions of Groups 2 and 5 and the alleged distinctness therebetween, the examiner then contends that "the container could be used to provide a different liquid such as water or could be used to furnish liquid to a different location."

Applicant notes that this is the same assertion proffered by the examiner with respect to the restriction requirement between the claims of Group 2 and the claims of Group 4 as addressed immediately above. Applicant incorporates by reference applicant's arguments as set forth above. Additionally, applicant respectfully notes that the examiner has again failed to address the patentability prong of the distinctness test, once again ignoring that the prong of the test. Applicant respectfully notes that it is the examiner's burden to show such patentability and in the absence of the same, the restriction requirement made by the examiner is improper.

Accordingly, applicant respectfully submits that the examiner's basis for asserting distinctness as between the inventions of Groups 2 and 5 is misplaced and, hence, the restriction between the inventions of Groups 2 and 5 should be reconsidered and withdrawn.

**The “Process/Apparatus for its Practice” Restriction-- MPEP 806.05(e)--
Group 3 vis-à-vis Group 4**

In contending that the inventions of Groups 3 and 4, which are for method and apparatus respectively, are distinct the examiner still again asserts that distinctness follows if it can be shown either that the process as claimed can be practiced by another materially different apparatus or by hand or that the apparatus as claimed can be used to practice another and materially different process; the examiner once again cites section 806.05(e) of the Manual of Patent Examining Procedure in support of this position. Further respecting the inventions of Groups 3 and 4 and the alleged distinctness therebetween the examiner then contends that “the container could be used to provide a different liquid such as water or could be used to furnish liquid to a different location.”

Applicant notes that this is the same position proffered by the examiner with respect to the restriction requirement between the claims of Group 2 and the claims of Group 5 as addressed immediately above and the claims of Group 2 and the claims of Group 4 as addressed penultimately above. Applicant incorporates by reference applicant’s arguments as set forth in the two sections immediately above. Additionally, applicant once again respectfully notes that the examiner has repeatedly failed to address the patentability prong of the distinctness test, once again ignoring the patentability prong of the test. Applicant respectfully notes that it is the examiner’s burden to show such patentability and in the absence of the same, the restriction requirement made by the examiner is improper.

Accordingly, applicant respectfully submits that the examiner's basis for asserting distinctness as between the inventions of Groups 3 and 4 is misplaced and, hence, that the restriction between the inventions of Groups 3 and 4 should be reconsidered and withdrawn.

**The "Process/Apparatus for its Practice" Restriction-- MPEP 806.05(e)--
Group 3 vis-à-vis Group 5**

In contending that the inventions of Groups 3 and 5, which are for process and apparatus respectively, are distinct the examiner asserts that distinctness follows if it can be shown either that the process as claimed can be practiced by another materially different apparatus or by hand or that the apparatus as claimed can be used to practice another and materially different process; the examiner cites section 806.05(e) of the Manual of Patent Examining Procedure in support of this position. Further respecting the inventions of Groups 3 and 5 and the alleged distinctness therebetween the examiner then contends that "the container could be used to provide a different liquid such as water or could be used to furnish liquid to a different location."

Applicant notes that this is the same position proffered by the examiner with respect to the restriction requirement between the claims of Group 2 vis-à-vis Group 4, the claims of Group 2 vis-à-vis Group 5 and the claims of Group 3 vis-à-vis Group 4, all as addressed immediately above. Applicant incorporates by reference applicant's arguments as set forth above. Additionally, applicant still again respectfully notes that the examiner has failed to address the patentability prong of the distinctness test, yet once again apparently ignoring

that prong of the test. Applicant again respectfully notes that it is the examiner's burden to show such patentability and in the absence of the same, the restriction requirement made by the examiner is improper.

Accordingly, applicant respectfully submits that the examiner's basis for asserting distinctness as between the inventions of Groups 3 and 5 is misplaced and, hence, that the restriction between the inventions of Groups 3 and 5 should be reconsidered and withdrawn.

The "Combination/Subcombination" Restriction-- MPEP 806.05(c)--Group 1 vis-à-vis Group 4

In contending that the inventions of Groups 1 and 4, which are allegedly for a combination and subcombination respectively, are distinct, the examiner asserts that distinctness follows as if can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations; the examiner cites section 806.05(c) of the Manual of Patent Examining Procedure in support of this position. Further respecting the inventions of Groups 1 and 4 and the alleged distinctness therebetween the examiner then contends that "in the instant case, the combination claimed does not require the particular of the subcombinations as claimed because the combination does not require 'a flexible diaphragm separating said cover from said cavity' for example. The subcombination is separate utility such as pumping water or oil from a well."

Furthermore, the claims of Group 1 generally recite apparatus for supplying liquid color to a plastic material processing machine comprising of sealable container for storing liquid color therewithin, a pump within the container having an inlet proximate the container bottom and a conduit connected to an end of the pump and passing through the container to deliver liquid color at the container exterior. The claims from Group 4 are directed to a liquid color diaphragm pump which includes a body having a cavity formed therein, a cover connected to the body, a flexible diaphragm separating the cover from the cavity, with the cover having a relief remote the portion of the diaphragm separating the cover from the cavity providing space between the cover and the diaphragm, means for cyclically displacing the diaphragm away from the relief area of the cover and into the cavity and means for biasing the diaphragm away from the cavity towards the relief area of the cover and into the space during a portion of each reciprocating cycle of diaphragm displacement. Applicant respectfully notes that the examiner has not made any showing that the combination, as represented by one claim of Group 1, namely claim 1 of the application, does not require the particulars of the subcombination, namely claim 38 directed to the liquid color diaphragm pump, for patentability. This is the first prong of the distinctness test for the combination/subcombination restriction. Applicant respectfully further notes that the test is two-pronged and that both prongs of the test must be satisfied before distinction can be found. All the examiner has done, in contending that that combination claim, namely claim 1, does not require the particulars of the subcombination, namely claim 38, because the combination

claim does not require “a flexible diaphragm separating said cover from the cavity” is to state the obvious--that claim 1 is broader than claim 38. There has been no showing that the broad claim, namely claim 1, does not require the particulars of the narrow claim, namely the alleged subcombination claim set forth as claim 38, for patentability.

Moreover, applicant respectfully disputes the proposition that claim 38 is properly characterizable as a subcombination of claim 1. Claim 38, like claim 1, being directed to a pump is effectively directed to apparatus for supplying liquid color to a plastic material processing machine, which is the subject matter to which claim 1 is directed. For claim 38 to be a proper subcombination of claim 1, it is incumbent on the examiner to demonstrate that claim 38 by itself is a subset of certain of the elements of claim 1. In other words, the examiner would have had to demonstrate that claim 38 was directed to either “a sealable container” or “a pump within the sealable container” or “a conduit connected to the outlet of the pump and passing through the container” which are the three elements of claim 1. The examiner has done none of this. Accordingly, applicant respectfully submits that not only has there not been a showing that the combination as claimed does not require the particulars of the subcombination as claimed for patentability, but that the examiner has not even correctly characterized claim 38 and the other claims of Group 4 as being a “subcombination” of the claims of Group 1. Reconsideration of the characterization of the claims of Group 4 and withdrawal of the restriction requirements as between Group 1 and Group 4 is respectfully solicited.

Moreover, applicant, for purposes of restriction analysis only, takes issue with the assertion that the claims of Group 38 have utility by themselves or in other combinations vis-à-vis the claims of Group 1. The examiner has not made any showing of this in that the so called "subcombination" claims are asserted to have a utility such as pumping water or oil from a well; there is no showing as to why the claims of Group 1 could not have the same utility, namely, to be used for pumping water or oil from a well.

Accordingly, applicant respectfully submits that the examiner's basis for asserting distinctness as between the inventions of Groups 1 and 4 is misplaced and, hence, that the restriction between the inventions of Groups 1 and 4 should be reconsidered and withdrawn.

The "Combination/Subcombination" Restriction-- MPEP 806.05(c)--Group 1 vis-à-vis Group 5

In contending that the inventions of Groups 1 and 5, which are allegedly for a combination and subcombination respectively, are distinct, the examiner asserts that distinctness follows as if can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations; the examiner cites section 806.05(c) of the Manual of Patent Examining Procedure in support of this position. Further respecting the inventions of Groups 1 and 5 and the alleged distinctness therebetween the examiner then contends that "in the instant case, the combination claimed does not require the particular of the subcombinations as claimed because the

combination does not require 'a flexible diaphragm separating said cover from said cavity" for example. The subcombination is separate utility such as pumping water or oil from a well."

Applicant traverses and takes issue with this position by the examiner. The examiner has not made any showing that the claims of Group 1, namely claim 1 and others which represent the combination as claimed, do not require the particulars of the subcombination, namely the claims of Group 5, for patentability. The official action is silent respecting the patentability of the claims of Group 1 whether or not the limitations of the claims of Group 5 are incorporated therein. Accordingly, this is a failure on the part of the examiner to address the first prong of the distinctness test as between restriction of the claims of Group 1 vis-à-vis the claims of Group 5 and, in applicant's view renders the restriction requirement deficient.

Applicant respectfully notes that applicant takes this position for restriction analysis only; applicant does **not** admit or concede in any way that the claims of Group 1 require the limitations set forth in the claims of Group 5 for unobvious patentability.

Applicant does not dispute the examiner's position that the subcombination, namely the claims of Group 5, have separate utility from the pump apparatus forming the basis for the claims of Group 1. However, in view of the failure of the restriction requirement to address the first of the two required prongs of the distinctness test for combination/subcombination distinctness and

consequent restriction, the restriction requirement as between the claims of Group 1 and the claims of Group 5 is flawed.

Accordingly, applicant respectfully submits that the examiner's basis for asserting distinctness as between the inventions of Groups 1 and 5 is misplaced and, hence, that the restriction between the inventions of Groups 1 and 5 should be reconsidered and withdrawn.

The "Combination/Subcombination" Restriction-- MPEP 806.05(c)--Group 2 vis-à-vis Group 3

In contending that the inventions of Groups 2 and 3, which are allegedly for a combination and subcombination respectively, are distinct, the examiner asserts that distinctness follows as if can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations; the examiner cites section 806.05(c) of the Manual of Patent Examining Procedure in support of this position. Further respecting the inventions of Groups 2 and 3 and the alleged distinctness therebetween the examiner then contends that "in the instant case, the combination claimed does not require the particular of the subcombinations as claimed because the combination does not require 'a flexible diaphragm separating said cover from said cavity' for example. The subcombination is separate utility such as pumping water or oil from a well."

Applicant traverses and take issue with this position by the examiner. The examiner's position respecting the position between the claims of Group 2 and

the claims of Group 3 is that the claims of Group 2, which are directed to a method for furnishing liquid color to a plastics resin processing machine, are combination claims, whereas the claims of Group 3, which are directed to a method for supplying liquid color as a portion of plastic resin material to be further fabricated by molding or extrusion, represents subcombination claims.

Applicant respectfully notes that the method claims of Group 2, namely independent claim 31, are silent as to where the liquid color material is supplied, reciting only in the preamble that the material is to be supplied to a plastics resin processing machine, but not specifying the locale of such a machine. The claims of Group 3 are different in that those claims recite supplying liquid color and resin material in a way that to be used by a gravimetric blender by pumping the material from a container using a diaphragm pump located in the container.

Applicant respectfully notes that there has been no showing by the examiner that the method claims of Group 2, namely independent claim 31, require any of the particular limitations recited in the claims of Group 3, which are also method claims, for patentability. Accordingly, applicant respectfully submits that there is a failure on the part of the restriction requirement to address the first of the two prongs of the distinctness test for combination/subcombination restriction; this being the case, the restriction requirement as between the claims of Group 2 and the claims of Group 3 is fundamentally flawed.

Applicant does not dispute the examiner's position that the claims of Group 3 may have separate utility in that the claims of Group 3 recite providing a liquid color into the weigh bin of a gravimetric blender by pumping the liquid color

material from a container of the same using a diaphragm pump located in the container; this limitation is not part of the claims of Group 2. Moreover, the claims of Group 2 do not address, in the independent claim, use of any gravimetric blender or supplying liquid color to the same. Accordingly, applicant agrees with the examiner that there is separate utility for the claims of Group 3 vis-à-vis the claims of Group 2. However, this does not save the distinctness showing the required respecting the restriction requirements since there has been no showing of an unobvious patentability of the claims of the two groups independently of each other as required for distinctness and, hence, restriction in the combination/subcombination context.

Accordingly, applicant respectfully submits that the examiner's basis for asserting distinctness as between the inventions of Groups 2 and 3 is misplaced and, hence, that the restriction between the inventions of Groups 2 and 3 should be reconsidered and withdrawn.

The "Subcombinations Allegedly Usable Together" Restriction--MPEP 806.05(d)--Group 4 vis-à-vis Group 5

In contending that the inventions of Groups 4 and 5, which are allegedly for subcombinations disclosed as being usable together in a single combination, are distinct, the examiner asserts that distinctness follows as if can be shown that the subcombinations are separately useable; the examiner cites section 806.05(d) of the Manual of Patent Examining Procedure in support of this position. Further respecting the inventions of Groups 4 and 5 and the alleged distinctness

therebetween the examiner then contends that "in the instant case, invention 5 has separate utility such as in a gravity feed situation, without any pump. Also invention 6 could be used with a simple one piece conduit rather than the structures of invention 5." Applicant traverses and takes issue with this position by the examiner. The claims of Group 4, which claim 38 is representative, are directed to a liquid color diaphragm pump and generally recite a body having a cavity formed therein, a cover connected to the body, a flexible diaphragm separating the cover from the cavity with the cover having a relief formed therein, a portion of the diaphragm separating the cover from the cavity and means for cyclically displacing the diaphragm away from the relief area to the cover and into the cavity together with means for biasing the diaphragm away from the cavity. The claims of Group 5 are directed to apparatus for driplessly furnishing liquid color for subsequent processing and talking of two conduits that are connectable together with a sleeve and a latching means. Applicant respectfully submits that while the examiner's characterization of the claims of Group 5 is correct in that the claims of Group 5 have separate utility, such as in a gravity feed situation, and it is further correct that the liquid color diaphragm pump generally defined by the claims of Group 4 could be used without the structure of the claims of Group 5, the fact of the matter is that the apparatus defined by the claims of Group 5 is designed to be used with a liquid color diaphragm pump as defined by the claims of Group 4. This being the case, even if these two groups of inventions are distinct, it surely is the case that a search relative to the patentability of the claims of Group 4 should cross over into the classes for the claims of Group 5

since the apparatus of the type to which the claims of Group 5 relate may very well be disclosed as being in combination with the types to which the claims of Group 4 relate. Similarly, in analyzing the patentability of the claims of Group 5, the appropriate classes for the claims of Group 4 should also be searched since liquid color diaphragm pumps of the type to which the claims of Group 4 relate may well be disclosed having dripless conduit means connected thereto of the type contained as to the claims of Group 5. Accordingly, applicant respectfully submits that the searches respecting the claims of Group 4 and the claims of Group 5 would be coincident and overlapping and, accordingly, even if there is distinctness between the two groups of claims, the restriction requirement is inappropriate.

Accordingly, applicant respectfully submits that the examiner's basis for asserting restriction between the inventions of Groups 4 and 5 should be reconsidered and withdrawn.

The Required Scope Of The Search

The most salient consideration for insisting upon restriction and determining the propriety of a restriction requirement is the scope of the examiner's search for prior art. Applicant is entitled to a full and thorough search of the prior art as a consequence of having filed his application and having paid the statutory application fee:

The director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent

under the law, the director shall issue a patent therefor. 35 U.S.C.
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Restriction is proper only where an examiner would be unduly burdened by searching numerous, **unrelated** inventions or technologies. The scope of a search for related inventions, even though possibly burdensome, cannot by itself justify restriction of related inventions. If an application includes claims to related inventions that are distinct or independent inventions, the examiner **must** examine the application on its merits, in its entirety, if the search and examination of the entire patent application can be made without a serious burden on the examiner:

If the search and examination of **an entire application** can be made without serious burden, the examiner **must examine it on the merits, even though it includes claims to independent or distinct inventions**. MPEP 803.

In developing a search strategy and mapping the scope of a search, claims are to be given their broadest reasonable interpretation, both literally and by equivalents:

All subject matter that is the equivalent of the subject matter as defined in the claim, even though specifically different from the definition in the claim, must be considered unless expressly excluded by the claimed subject matter. MPEP 904.01(b)

The examiner will not be unduly burdened by searching and examining all of the claims presented by applicant in a single application. The examiner's search will not be narrowed or reduced by compliance with the restriction requirement, since applicant has clearly manifested his intent to claim each novel

and nonobvious aspect of the disclosed subject matter as evidenced by the claims in the application.

The examiner's instructional guidelines for performing a search for any application are set forth in the MPEP. The guidelines require the examiner to search in classes and subclasses in which arguably "distinct" (as defined by the MPEP) inventions would be classified:

"Not only must the art be searched with which the invention claimed is classifiable, but **also all analogous arts regardless of where classified.**

The determination of when arts are analogous is at times difficult. It depends upon the necessary essential function or utility of the subject matter covered by the claims, and not upon what it is called. MPEP 904.01(c) (emphasis added).

A proper field of search normally includes the subclass in which the claimed subject matter of an application would be properly classified...

In outlining a field of search the examiner should note every class and subclass under the U.S. Patent Classification system and other organized systems of literature, **that may have material pertinent to the subject matter as claimed.** Every subclass, digest and cross reference art collection pertinent to each type of invention claimed should be listed, from the largest combination through the various subcombinations to the most elementary part. **The search should extend to all probable areas relevant to the claimed subject matter and should cover the disclosed features which might reasonably be expected to be claimed.** MPEP 904.02(a) (emphasis added).

It is a prerequisite to a speedy and just determination of the issues involved in the examination of an application that a careful and comprehensive search, **commensurate with the limitations appearing in the most detailed claims** in the case, be made in preparing the first action ... It is normally not enough that references be selected to meet only the terms of the claims alone, especially if only broad claims are presented; **but the search should, insofar as possible, also cover all subject matter which the examiner reasonably anticipates might be incorporated into applicant's amendment.** MPEP 904.03, ¶ 1 (emphasis added)

In doing a complete search, the examiner should find and cite references that, while not needed for treating the claims, would be useful for forestalling the presentation of claims to other subject matter regarded by applicant as his or her invention, by showing that this other subject matter is old or obvious. MPEP 904.03 ¶ 2

In selecting the references to be cited, the examiner should carefully compare the references with one another and with the applicant's disclosure... MPEP 904.03 ¶ 3.

From the above-quoted guidelines, it is clear that the scope of a proper search includes:

- (1) Classes and subclasses in which the claimed subject matter is classified;
- (2) Classes and subclasses that may have material pertinent to the claimed subject matter;
- (3) Classes and subclasses containing subject matter present in the disclosure which might reasonably be expected to be claimed during the prosecution; and
- (4) Classes and subclasses that may contain subject matter disclosing material related to features which might reasonably be expected to be claimed.

Given this mandate, Applicant submits that all of the classes defined by the examiner as those in which the claims of this application arguably reside, must be searched no matter which group of claims Applicant elects for immediate prosecution.

The Proposed Restriction Would Be Unduly Economically Burdensome On Applicant

While the Patent and Trademark Office has a legitimate interest in obtaining proper revenue from filing, issuance and maintenance fees, it does not

have unrestrained power to tax inventors or the entrepreneurial enterprises employing them. Applicant is entitled to obtain patent protection on each of the nonobvious inventive aspects of the subject matter which applicant has disclosed. If the applicant is forced to divide this application into five separate patent applications as suggested by the examiner, this will be unduly and unfairly burdensome to the applicant due to the extra fees and costs associated with prosecuting and maintaining three additional patents.

Table 1 sets forth the divisional application filing costs which would be incurred by the applicant in the event the restriction requirement stands:

TABLE 1: DIVISIONAL APPLICATION FILING COST

Group Number	I	II	III	IV	V
Independent Claims	5	3	2	1	3
Excess Independent Claims	2	0	0	0	0
Excess Independent Claim Fee	\$86.00	\$0	\$0	\$0	\$0
Total Claims	50	20	3	11	13
Excess Claims	30	0	0	0	0
Excess Claims Fee	\$270.00	\$0	\$0	\$0	\$0
Basic Filing Fee	\$385.00	\$385.00	\$385.00	\$385.00	\$385.00
Total Filing Fee	\$731.00	\$385.00	\$385.00	\$385.00	\$385.00
Total of All Filing Fees	\$2,271.00				

Already Paid by Applicant at Filing	\$1,129.00
Already Paid by Applicant to Add Claims 68-96	\$ 387.00
Filing & Claims Fees Paid by Applicant to Date	\$1,516.00

As can be seen from Table 1, Applicant will be forced to pay additional filing fees in the amount of \$775.00 to file divisional applications in the event the restriction requirement is not withdrawn.

As further indicated on Table 1, Applicant has already paid \$2,271.00 in filing and claims fees to date. If Applicant is forced to adhere the restriction requirement and Group 1 is the group of claims which is examined, \$1540.00 of this will be forfeited since nine independent claims and 48 claims in total will not be examined in the instant application despite the fact that applicant has paid the fees therefor. Indeed, applicant will be forced to pay \$1540.00 additional to secure examination of the nine extra independent claims and the 48 total extra claims for which applicant has already paid. Hence, applicant will incur an initial, non-recoverable penalty of \$3080.00 ($\$1540.00 + \1540.00) in the event applicant is required to adhere to the outstanding restriction requirement and file divisional applications for the four non-elected groups of claims.

Applicant further notes that the figures given in Table 1 do not include attorney fees, associated costs and expenses. The attorney fees associated with filing each such divisional patent application will probably be around \$1,000.00; this figure is taken by analogy from the figure appearing in the AIPLA Report of Economics Survey 2003 for the filing of a patent application as a PCT application in the United States as the receiving office where the patent application filed was based on either a previously prepared U.S. patent application as the PCT application or was a foreign origin PCT application.

Furthermore, applicant will be faced with preparing amendments and arguments in response to official actions to be issued by the United States Patent and Trademark Office. Again based on the AIPLA Report of Economic Survey 2003, from figures given for the costs to prepare an amendment and argument of minimal complexity, it can be expected that the applicant will face fees of in the neighborhood of \$2,200.00 for each amendment and argument which may be required in response to an official action. Additionally, there will be attorney fees associated with the payment of any issue fee if allowed claims are obtained and this will amount to about \$700.00 per application, again based on the AIPLA Report of Economic Survey 2003. Add to this fees for the preparation and filing of information disclosure statements, and the ordinary and routine reporting letters to the client, the result is that the attorney fees associated with the filing and prosecution of four (4) divisional applications could easily amount to \$7,000.00 or \$8,000.00 per application, leading to a further incremental cost to the applicant from \$28,000.00 to \$32,000.00 if the restriction requirements stands.

Table 2 presents the patent issue fees and maintenance costs applicant will face in the event the restriction requirement stands and applicant is successful in prosecuting the parent application and four divisional applications to allowance:

TABLE 2: PATENT MAINTENANCE COST

Number of Patents	1	2	3	4	5
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Issue and Publication Fees	965.00	1,930.00	2,895.00	3,860.00	4,825.00
1 st Maintenance Fee	455.00	910.00	1,365.00	1,820.00	2,275.00
2 nd Maintenance Fee	1,045.00	2,090.00	3,135.00	4,180.00	5,225.00
3 rd Maintenance Fee	<u>1,610.00</u>	<u>3,220.00</u>	<u>4,830.00</u>	<u>6,440.00</u>	<u>8,050.00</u>
TOTAL	\$4,075.00	\$8,150.00	\$12,225.00	\$16,300.00	\$20,375.00

Even from Table 2, which presents the maintenance fee costs at today's February 2004 levels, it is apparent that applicant will face issue and maintenance fees amounting to \$16,300.00 extra, over and above the cost to issue and maintain a single patent directed to the invention, if the restriction requirement stands. When this figure is combined with the figures discussed above, the total financial penalty applicant potentially faces in just official fees amounts to \$18,007.00 as a result of the restriction requirement. Applicant respectfully submits that applicant should not be burdened in this manner and that the restriction requirement should be reconsidered and withdrawn in its entirety.

**The Patent Office's Responsibility Is Public Service,
Not Revenue Generation**

While applicant recognizes the Patent and Trademark Office interest in obtaining proper revenue from filing and issuance fees, the Patent and Trademark Office is not in the business of assisting the IRS in financing the war on terrorism or reducing the national debt. The sole function of the Patent and Trademark Office is to serve inventors and the public in an efficient and expeditious manner. The Patent and Trademark Office is charged with a duty to carry out its responsibility of examining patent applications thoroughly and efficiently. Efficient use of administrative resources and expeditious processing of this application will be better served by performing one comprehensive search, as contrasted to five largely, if not completely, overlapping searches of the classes defined by the examiner in levying the erroneously-based restriction requirement.

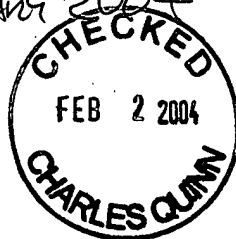
Conclusion


For all of the foregoing reasons, applicant respectfully submits that the restriction requirement set forth in the paper dated October 2, 2003 is not well founded and should be withdrawn. Applicant again requests prompt and thorough examination of all of the claims pending in the application.

In the event there is any fee required in connection with this submission, please charge the same to applicant's undersigned counsel's Deposit Account No. 50-1943.

Respectfully submitted,

Date: 25 FEBRUARY 2004



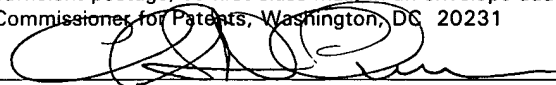

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I hereby certify that this paper, along with any paper referred to as being attached or enclosed, is being deposited with the United States Postal Service on the date indicated below, with sufficient postage, as first class mail, in an envelope addressed to: Commissioner for Patents, Washington, DC 20231


(signature)

BY: Charles N. Quinn

DATE: 2/2/2004

